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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mathias Destarac

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EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT

PAPER NUMBER

1792

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/507,330	<b>Applicant(s)</b> DESTARAC ET AL.	
	<b>Examiner</b> Elena Tsoy Lightfoot	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-66 is/are pending in the application.
- 4a) Of the above claim(s) 40-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

Amendment filed on January 7, 2009 has been entered. New claims 65-66 have been added. Claims 40-66 are pending in the application. Claims 40-57 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Abstract***

The abstract of the disclosure filed on January 7, 2009 has been entered.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Rejection of claims 61-62 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 58-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al (US 6191056) in view of Simpson et al (US 6287706) and Maeda et al (US 6146806), further in view of Berge et al (EP 1156089).

The cited prior art for the reasons of record set forth in paragraph 4 of the Office Action mailed on 7/07/2008.

As to continuous film, Vogt et al teaches a fabric comprising a metal coating wherein said metal coating comprises *discrete* metal particles which are **encapsulated** (by forming continuous film on each metal particle) within a cross-linked polyurethane latex, wherein said discrete metal particles are treated with a primer coating composition (See column 2, lines 37-39). Since the Applicants' specification defines: "The term "metal surface", within the meaning of the invention, is to be understood as the surfaces of materials based on metals or on semimetals" (See P3 of Published Application); and there is no limitation to the shape or dimensions of the metal surface, the surface of each metal particle in Vogt reads on claimed "metal surface" as defined by the Applicants' specification. Thus, Vogt forms a continuous coat on **continuous** metal surface of the particle, as required by amended claim 58 and new claim 66.

As to claim 65, Vogt et al teaches an **aqueous** primer coating composition (See column 6, lines 60-61).

5. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al in view of Simpson et al and Maeda et al, further in view of Berge et al, and further in view of Chen (US 5306764) for the reasons of record set forth in paragraph 5 of the Office Action mailed on 7/07/2008.

### ***Response to Arguments***

Applicants' arguments filed January 7, 2009 have been fully considered but they are not persuasive.

(A) Applicants argue that Vogt, in contrast, to claim 58 teaches a primer coating for providing metallized fabric with improved washfastness by applying a primer composition onto "*discrete* metal particles..." See Vogt at col. 2, lines 37-40 (emphasis added) not a continuous coat as recited by Claim 58. Indeed, provision of a continuous coat represents a completely different physical application to discrete particles because a continuous coat might not function under such circumstances.

The Examiner respectfully disagrees with this argument. The Applicants' specification defines: "The term "metal surface", within the meaning of the invention, is to be understood as the surfaces of materials based on metals or on semimetals" (See P3 of Published Application). There is no limitation to the shape or dimensions of the metal surface. Therefore, the surface of each metal particle in Vogt reads on claimed "metal surface" as defined by the Applicants' specification. Vogt forms a continuous coat on each metal particle.

(B) Applicants submit that Simpson and Maeda do not teach that a random copolymer is functionally equivalent to a block copolymer for use in adhesion promoters and/or protective agents such as in the present invention. There is also no reason or suggestion provided in these references regarding the effectiveness of block copolymers as coatings on particles to improve washfastness (which is why one of ordinary skill in the art would carry out the combination in the first place.) Simpson teaches sheet materials for floor coverings. The Office Action cites Simpson's statement that "the polyalkene or polyolefin resins used in accordance with the present invention may be of various different types including random bipolymers and terpolymers, and block copolymers, based on a variety of monomer units..." See Office Action at 4 and Simpson at col. 9, line 66 -col. 10, line 22. Maeda teaches photoresist compositions for lithography. The Office Action cites Maeda's statement that "the polymer is not limited to only the case where each unit in the above formula forms a predetermined arrangement and may also be, for example, a random or block copolymer of these monomer units." See Office Action at 4 and Maeda at col. 8, lines 55-58. Applicants respectfully submit that the teachings of Simpson and Maeda are limited to the subject matter of the respective references and are not teachings that random copolymers are always functionally equivalent to block copolymers in all applications, and particularly in the metallized fabric technology disclosed by Vogt, or in the technology of the present invention. One of ordinary skill in the art would not have had reason to combine the teachings of Simpson and Maeda with the teachings of Vogt because all three references relate to technologies that are both disparate from one another and different from technology of the present application.

The Examiner respectfully disagrees with this argument. One of ordinary skill in the art would know that chemical properties of a coating composition do not change where one uses it. Good car paint would be weather resistant on any outdoor metal object as on the car. For example, outdoor metal cistern coated with a car primer for metal surfaces and good car paint would be as weather resistant as on the car.

(C) Applicants submit that that a prima facie case of obviousness has not been established because Berge does not provide a reason for modifying the process of Vogt to arrive at the present invention. Berge addresses the problem of hydrogen gas evolution from the introduction of metallic flakes into water based solvents. Applicants respectfully submit that Berge does not address the problem of coating metal surfaces to improve their adhesion and/or corrosion resistance characteristics, and the teachings of Berge are inapposite, as hydrogen gas

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evolution is not a demonstrated problem in known in the art of coating metal surfaces. For at least these reasons, Applicants respectfully request withdrawal of the rejection of claims 58-64 as obvious over Vogt in view of Simpson and Maeda, in further view of Berge.

The Examiner respectfully disagrees with this argument. First of all, it is well settled that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. Primary reference of Vogt teaches random polymer. Secondary references of Simpson and Maeda teach that a random polymer is chemically functionally equivalent to a block polymer. Berge is a tertiary reference which is relied upon to show that the addition of a neutralized phosphated segmented (block) copolymer dispersed in an aqueous carrier to aqueous metallic flakes such as aluminum flakes containing coating composition provides improved glamour, strong adhesion of aluminum surface and reduces generation of hydrogen gas from aluminum flakes in water. Therefore, one of ordinary skill in the art would have strong motivation to use a block polymer instead of a random polymer of Vogt since teachings of Simpson and Maeda, and one of ordinary skill in the art would have reasonable expectation of success in using a block polymer, as taught by Berge.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.  
Primary Examiner  
Art Unit 1792

February 9, 2009

/Elena Tsoy Lightfoot/